

REMARKS

This paper responds to the Office Action mailed on March 11, 2009.

Claim 17 is herein amended. Claims 1-16 remain canceled. Claims 37-41 remain withdrawn, and no claims are added. As a result, claims 17-41 are now pending in this application.

§ 101 Rejection of the Claims

Claims 17-27 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. The United States Court of Appeals for the Federal Circuit (CAFC) has held that satisfaction of the machine-or-transformation test imparts patent eligibility under § 101.¹ “The machine-or-transformation test is a two-branched inquiry; an applicant may show that a process claim satisfies § 101 either by showing that his claim is tied to a particular machine, or by showing that his claim transforms an article.”² The CAFC added that certain considerations are applicable to analysis under either branch. First, “the use of a specific machine or transformation of an article must impose meaningful limits on the claim’s scope to impart patent eligibility.”³ Second, “the involvement of the machine or transformation in the claimed process must not merely be insignificant extra-solution activity.”⁴ Independent claim 17, as amended, satisfies the machine branch of the machine-or-transformation test.

Independent claim 17, as amended, recites, in part, “the providing of the answer *performed by a module implemented by a processor of a computer system and configured by instructions stored in a memory of the computer system.*”⁵ A computer system is a machine. Accordingly, a module implemented by a processor of the computer system and configured by instructions stored in a memory of the computer system is tied to a machine, namely, the computer system. The use of this machine imposes meaningful limits on the claim’s scope, because the module must be implemented by the processor and configured by instructions stored in a memory. The involvement of this machine is not merely insignificant extra-solution

¹ *In re Bilski*, 545 F.3d 943, 88 U.S.P.Q.2d (BNA) 1385 (Fed. Cir. 2008).

² *Id.*, at 961.

³ *Id.*, at 961.

⁴ *Id.*, at 962.

⁵ Claim 17, emphasis added.

activity, because the module lies at the heart of the claimed subject matter, performing the titular operation of the instant application. Therefore, claim 17 meets the machine branch of the machine-or-transformation test. For at least these reasons, independent claims 17 and its dependent claims are directed to statutory subject matter. Thus, Applicants respectfully request that these rejections be withdrawn and the claims be allowed.

Claim 35, expressed in means-plus-function language, was rejected under 35 U.S.C. § 101 “because the specification means includes the claiming of a signal or otherwise the claim may be interpreted as software per se.”⁶ 35 U.S.C. § 112, sixth paragraph states that a claim limitation expressed in means-plus-function language “*shall* be construed to cover the corresponding *structure* described in the specification and equivalents thereof.”⁷ Structure supporting claim 35 is described in Applicants’ specification, for example, in FIG. 14 and paragraphs 00126 – 00129, which describe a “*machine* in the exemplary form of a computer system 1000 within which a set of instructions, for causing the machine *to perform any one of the methodologies discussed above*, may be executed.”⁸ Accordingly, Applicants respectfully request that the means-plus-function language of claim 35 be construed to cover the corresponding structure described in Applicants’ specification and equivalents thereof, as required under 35 U.S.C. § 112, sixth paragraph. Thus, Applicants respectfully request that this rejection be withdrawn and the claim be allowed.

§ 112 Rejection of the Claims

Claim 35 was rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. The Office Action stated that “the examiner is unable to determine if the means for features are software or hardware.”⁹ As noted above, claim 35 is expressed in means-plus-function language that “*shall* be construed to cover the corresponding *structure* described in the specification and equivalents thereof.”¹⁰ Since Applicants’ specification recites corresponding structure,¹¹ Applicants respectfully request that the means-plus-function language of claim 35 be construed

⁶ Office Action, page 3.

⁷ 35 U.S.C. § 112; *see also* MPEP 2181(II), first paragraph.

⁸ Specification, paragraph 00126, emphasis added.

⁹ Office Action, page 3.

¹⁰ 35 U.S.C. § 112; *see also* MPEP 2181(II), first paragraph.

¹¹ E.g., specification, FIG. 14 and paragraphs 00126-00129.

to cover the corresponding structure described in Applicants' specification and equivalents thereof, as required under 35 U.S.C. § 112, sixth paragraph. Thus, Applicants respectfully request that this rejection be withdrawn and the claim be allowed.

§ 102 Rejection of the Claims

Claims 17-36 were rejected under 35 U.S.C. § 102(e) as being anticipated by Coffman et al. (U.S. Publication No. 2004/0215467, hereinafter "Coffman"). To anticipate a claim, a reference must teach ***every element*** of the claim,¹² as arranged in the claim,¹³ and in as complete detail as in the claim.¹⁴

Independent claim 17 recites, in part, "***receiving an indication from a seller to authorize provision*** of an answer" and "***selectively providing*** the answer . . . ***based on the indication.***"¹⁵ Independent claims 28, 35, and 36 contain similar limitations. The Office Action cited paragraphs 0136 to 0140 of Coffman as disclosing these elements.¹⁶ The cited paragraphs discuss a "link [that] allows the [RFQ] author to . . . ***display*** a window or log of questions and answers."¹⁷ Coffman states that "[b]y this method, suppliers . . . may ***post*** questions and ***see*** answers."¹⁸ Coffman further states that "[t]he Q&A Log . . . includes at least four fields, such as . . . ***response*** (text answering the question) [and] ***response author*** (the name of the individual answering the question)."¹⁹ Assuming, solely *arguendo*, that the "suppliers" of Coffman are sellers, nothing in Coffman discloses ***receiving an indication from a seller to authorize provision*** of an answer or selectively ***providing the answer based on the indication.*** As a result, Coffman fails to disclose at least these elements.

¹² "A claim is anticipated only if ***each and every element*** as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed Cir. 1987), emphasis added.

¹³ It is not enough, however, that the prior art reference discloses all the claimed elements in isolation. Rather, "[a]nticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, ***arranged as in the claim.***" *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 U.S.P.Q. 193 (Fed. Cir. 1983), emphasis added).

¹⁴ "The identical invention must be shown ***in as complete detail*** as is contained in the . . . claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989); MPEP § 2131; emphasis added.

¹⁵ Claim 17, emphasis added.

¹⁶ Office Action, page 4.

¹⁷ Coffman, paragraph 0136.

¹⁸ *Id.*, emphasis added.

¹⁹ *Id.*, paragraphs 0136 and 0140, emphasis added.

AMENDMENT AND RESPONSE UNDER 37 C.F.R § 1.111

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Page 9

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Because every element of independent claims 17, 28, 35, and 36 is not set forth in Coffman, claims 17, 28, 35, and 36 are not anticipated by Coffman. For at least these reasons, independent claims 17, 28, 35, and 36, and their respective dependent claims, are patentable over the cited reference. Furthermore, the dependent claims each may contain additional patentable subject matter. Thus, Applicants respectfully request that these rejections be withdrawn and the claims be allowed.

CONCLUSION

Applicants respectfully submit that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone the undersigned at (408) 278-4048 to facilitate prosecution of this application.

If necessary, please charge any additional fees or deficiencies, or credit any overpayments to Deposit Account No. 19-0743.

Respectfully submitted,

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 10th day of June, 2009.

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